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09/773,263	02/01/2001	Gerard K. Kunkel	WGATE11	4319

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EXAMINER

BELIVEAU, SCOTT E

ART UNIT PAPER NUMBER

2614

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/773,263

Applicant(s)

KUNKEL ET AL.

Examiner

Scott Beliveau

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.  
Provisional application No. 60/191,474, filed 23 March 2000, provides support for claims 1-4, 7-17, and 20-25. While provisional application 60/179,736 provides support for the limitations of 5, 6, 18, and 19, it does not provide support in combination with restricting accessibility to the demographic database. Claim 26 does not appear to be supported in either the instant application or the provisional applications as set forth in the subsequent rejection. Accordingly, claims 1-4, 7-17, and 20-25 shall be examined based on a priority date of 23 March 2000 and claims 5, 6, 18, 19, and 26 shall be accorded the filing date of the instant application or 01 February 2001.

### *Drawings*

2. Applicant's amendment to the specification so as to remove the reference to element "44" is acknowledged the previous objection pursuant to such is removed.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the newly added limitations wherein the "user demographic database [is] not accessible to said network headend and said distribution network" (Claims 1 and 14) as determined by a user input (Claim 26) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of

the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### *Response to Arguments*

4. Applicant's arguments with respect to claims 1, 14, and 26 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's amendment pertaining to the newly added limitation such that the database is not accessible to the network headend and the distribution network, such a limitation as noted by the applicant, is interpreted as being limited to whether or not the information associated with the database is being actively shared as opposed to the broader meaning of the term accessible. Simply because an item is not being shared does not necessarily equate to it not being accessible. For example, a person leaving their lunch with their name clearly labeled on the bag in a common office refrigerator is not choosing to share

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their lunch with others in the office. However, the lunch is still accessible to anyone with access to the refrigerator and the desire to steal the clearly labeled lunch.

With respect to applicant's arguments regarding claims 1, 13, 14, and 24 such that the Wachob reference fails to disclose that the particular limitation wherein the demographic database is not accessible to the network headend and the distribution network, the examiner respectfully disagrees. As noted in applicant's cited passages, it is noted that the particular embodiment associated with providing information upstream is an optional or alternative embodiment. In particular the reference discloses that the return path is optional (Col 10, Line 34-42) and utilizes alternative language such as "In the event that the cable system operator wants to provide research data . . ." and "If relevant market research data has been stored" (Col 8, Lines 17-23 and 46-51) with respect to the particular ability to share data upstream. Accordingly, it is the examiner's interpretation that the reference anticipates both the situations wherein the demographic information may be shared or may not be shared depending upon the desires of the system operator. The Bryant reference utilizes similar alternative language/embodiments wherein such that profile can be as opposed to must be distributed to different locations.

With respect to newly added claim 26, while the particular claim appears to be directed towards a separate embodiment of the invention of the instant application, it is noted that the particular usage of "capable of" language renders the limitation of the user input designating the database as being accessible a functional limitation for the purpose of applying prior art. Accordingly, as set forth in the grounds of rejection, the examination of the claim as

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presented does not present a serious burden in view of the art rejection applied to claims 1 and 14.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the examiner does not concur with applicant's argument that support for the limitation as to receiving "input controlling whether or not the user demographic database is accessible by the network headend and the distribution network". The examiner's interpretation of the cited section is such that the user is operable to change demographic information (ex. marital status), as opposed to controlling whether or not the demographic database is actually shared with the headend (IA: Page 5, Lines 1-21).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 14, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Sitnik (US Pat No. 6,160,570).

In consideration of claims 1 and 14, the Sitnik reference discloses a “system” and “method for transmitting information in a broadcast distribution system that is targeted to a system user” (Abstract). The system comprises a “network headend” [4], a “distribution network” [5/6], and a “plurality of terminal devices interfaced to said distribution network” [2] (Figure 1). The “network headend” through a “distribution network” [5/6] “transmits at least one information stream to a plurality of users” wherein “said information stream” is “comprised of a plurality of information selections and a plurality of corresponding codes . . . identifying a characteristic of a corresponding one of said selections that is employed to identify a system user to whom either said selection or additional information should be transmitted” (Col 3, Line 34 – Col 4, Line 34). The “plurality of terminal devices” [2], as illustrated in Figure 2, comprises a “terminal processor” [19] and a “user demographic database that contains demographic information about a corresponding user of said terminal device” [22] (Col 6, Line 34-43; Col 7, Line 41 – Col 8, Line 18). Upon receiving the aforementioned “information stream with said codes”, the “terminal processor” [19] “compares each code for each selection in said information stream with said demographic information in said database and determine[s] . . . whether said user is designated to receive

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said selection or additional information related to said selection” (Figure 3; Col 8, Line 19 – Col 9, Line 56).

With respect to the limitation wherein the “user demographic database” [22] is “not accessible to said network headend and said distribution network” (Claim 1) or just “not accessible to said network headend” (Claim 14), the term “accessible” is interpreted in light of the specification as referring to whether or not the demographic information is being shared. Given that the profile may be generated through an on-screen questionnaire or based upon passive monitoring and the advertisement selection is performed entirely locally, it need not be nor is disclosed as being “shared”.

In consideration of claim 26, the Sitnik reference discloses a “system for transmitting information in a broadcast distribution system that is targeted to a system user” (Abstract). The system comprises a “network headend” [4], a “distribution network” [5/6], and a “plurality of terminal devices interfaced to said distribution network” [2] (Figure 1). The “network headend” using “distribution network” [5/6] “transmits at least one information stream to a plurality of users . . . comprising a plurality of information selections and a at least one code corresponding to each information selection” (Col 3, Line 34 – Col 4, Line 34). The “plurality of terminal devices” [2], as illustrated in Figure 2, comprises a “terminal processor” [19] and a “user demographic database that contains demographic information about a user of said terminal device” [22] (Col 6, Line 34-43; Col 7, Line 41 – Col 8, Line 18). Upon receiving the aforementioned “information stream with said codes”, the “terminal processor” [19] “compares the code for each selection with the demographic information and determine[s] . . . whether said user is designated to receive said selection or additional



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information related to said selection” (Figure 3; Col 8, Line 19 – Col 9, Line 56). The prior art structure or terminal [2] does not explicitly disclose but is reasonably concluded as being “capable of receiving an input from the user” [25] which “controls whether or not the user demographic database is accessible by the network headend and the distribution network”.

9. Claims 1-4, 7-12, 14-17, 20-23, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Wachob (US Pat No. 5,155,591).

In consideration of claims 1 and 14, the Wachob reference discloses a “system” and “method for transmitting information in a broadcast distribution system that is targeted to a system user” (Abstract). The system comprises a “network headend” (Figure 5), a “distribution network” [74], and a “plurality of terminal devices interfaced to said distribution network” [10] (Figures 1 and 5). The “network headend” through a “distribution network” [74] “transmits at least one information stream to a plurality of users” wherein “said information stream” is “comprised of a plurality of information selections and a plurality of corresponding codes . . . identifying a characteristic of a corresponding one of said selections that is employed to identify a system user to whom either said selection or additional information should be transmitted” (Figure 3; Col 6, Lines 27-46; Col 7, Lines 18-21). The “plurality of terminal devices” [10] comprises a “terminal processor” [30] and a “user demographic database that contains demographic information about a corresponding user of said terminal device” [36] (Col 5, Line 61 – Col 6, Line 14). Upon receiving the aforementioned “information stream with said codes”, the “terminal processor” [30] “compares each code for each selection in said information stream with said demographic information in said database and determine[s] . . . whether said user is designated to receive

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said selection or additional information related to said selection” (Figure 3; Col 6, Line 47 – Col 8, Line 16).

With respect to the limitation wherein the “user demographic database” [36] is “not accessible to said network headend and said distribution network” (Claim 1) or just “not accessible to said network headend” (Claim 14), the term “accessible” is interpreted in light of the specification as referring to whether or not the demographic information is being shared. The Wachob reference, teaches that the particular sharing or “accessibility” of the information is based upon the wants of the cable provider (Col 8, Lines 17-23 and 46-51), as opposed to being required. Accordingly, it is the examiner’s interpretation that the limitation is met for the embodiment wherein system operator does not want to provide marketing information, and thus does not provide the receiver functionality to share market research data with advertisers.

Claims 2, 15, and 25 are rejected wherein the “headend” (Figure 5) “obtains said information selections” or advertisements” and “generates said codes and inserts said codes into the information stream . . . before a corresponding one of said information selections” using an “encoder” (Col 10, Lines 10-19).

Claims 3 and 16 are rejected wherein the “information stream is a video information stream, said broadcast distribution system is a cable distribution system and said terminal devices are each a set-top converter” (Col 4, Lines 26-55).

Claims 4 and 17 are rejected wherein “said information selection include advertisements” (Col 4, Lines 26-55).

Claims 7 and 20 are rejected wherein “said headend includes a multiplexer” [72] for “simultaneously transmitting a plurality of said information streams on a plurality of corresponding downstream channels that are interfaced between said distribution network and said terminal devices, [wherein] each said information streams includes information selections that are targeted to different user demographics”. Accordingly, each “terminal processor . . . is programmed to determine a selected one of said downstream channels on which a selected information selection targeted to a user of said terminal device is to be received and accesses said selected information selection” (Figure 3; Col 6, Line 27 – Col 7, Line 12).

Claims 8, 9, 21, and 22 are rejected wherein the “terminal device” [10] further comprises a “tuner for selecting a one of said downstream channels to receive” [18] and the “terminal processor” [30] is “further programmed to instruct said tuner to tune to said selected one of said downstream channels to receive said selected information selection” and to “instruct said tuner to tune to back to a previously selected channel after a designated one of said selections has been received” (Figure 3; Col 6, Lines 47-68; Col 7, Lines 13-54).

Claims 10 and 23 is rejected wherein the “information streams include at least one group of information selections, each selection of which is simultaneously transmitted with the other selections in said group, and is targeted to users having different demographics than those of users to which the other selections in said group are targeted” (Col 9, Line 20 – Col 10, Line 9; Col 10, Line 43 – Col 11, Line 8).

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Claim 11 is rejected wherein the “headend further includes an insertion module for inserting said groups of information selections into said information streams” [60] (Col 9, Lines 20-56).

Claim 12 is rejected wherein “each information selection in said groups comprises an advertisement” (Col 4, Lines 26-55).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
12. Claims 5, 6, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wachob (US Pat No. 5,155,591) in view of Ngo et al. (US Pat No. 6,574,793).

In consideration of claims 5 and 18, the Wachob reference does not particular disclose that the “terminal processor” programmed to provide a “prompt” if an appropriate

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advertisement is available as claimed. In a related art, associated with targeted delivery of information in video distribution systems, the Ngo et al. reference discloses a method wherein a “terminal processor” [38] is further “programmed to provide a prompt to a corresponding user if said processor determines that said user is designated to receive said additional information” (Figures 8-10; Col 6, Line 21 – Col 7, Line 17). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Wachob reference so as to provide a “prompt” for the purpose of advantageously providing a means that allows a viewer to interact with an advertisement in a manner that further maintains the privacy of the user (Ngo et al.: Col 1, Lines 42-59).

Regarding claims 6 and 19, it is unclear if the combined references necessarily comprise a “database” at the “headend” which stores the aforementioned “additional information that is to be made available to selected system users, based on the demographic information in the user demographic database” (Ngo et al.: Figure 3; Wachob: Col 9, Lines 20-23). The examiner takes OFFICIAL NOTICE that the particular usage of a “database” locatable at a headend is notoriously well known in the art. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to particularly utilize a “database” locatable at the headend end for the inherent advantages associated with the particular usage of a database including the ability to provide an organized storage means of additional information subsequently delivered to subscribers.

13. Claims 13 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wachob (US Pat No. 5,155,591) in view of Bryant et al. (US Pat No. 5,652,615).

In consideration of claims 13 and 24, the Wachob reference does not explicitly disclose nor preclude the usage of digital distribution techniques wherein “each information selection is transmitted in a different PID of a common digital channel”. The Bryant et al. reference discloses a method for delivering targeting advertising wherein “each information selection is transmitted in a different PID of a common digital channel” (Col 5, Line 41 – Col 7, Line 17). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the Wachob targeted advertisement distribution for the purpose of providing a means to distribute targeted advertisements in conjunction with an upgraded (ex. analog-to-digital) distribution network (Bryant et al.: Col 1, Line 55 – Col 2, Line 14). The particular usage of digital distribution techniques as opposed to analog further provides the commonly known advantage of enabling cable distributors to carry larger numbers of programming due to more efficient utilization of bandwidth. Accordingly, the particular usage of MPEG based distribution in conjunction with Wachob would further advantageously provide for the distribution of a greater number of commercials, hence more precisely targeted advertisements.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

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- The Aras et al. (US Pat No. 5,872,588) reference discloses a system and method wherein the user is operable to enable privacy features so as to disable the sharing of television viewership information.
- The Levitan (US Pat No. 5,534,911) reference discloses the usage of a local demographic profile which is inaccessible from any other point of the network including the headend (Col 2, Lines 63-68; Col 4, Lines 14-35).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB  
March 31, 2005

  
**JOHN MILLER**  
**SUPERVISORY PATENT EXAMINER**  
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